UNITED STATES PATENT AND TRADEMARK OFFICE

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10/764,345	01/23/2004	Tie Liu	MS1-1811US	5777

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EXAMINER
RAVETTI, DANTE

ART UNIT	PAPER NUMBER
3685	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *1/23/2004* .
2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,8,9 and 12-18* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-6,8,9 and 12-19* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on *1/23/2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1.   This communication is in response to Amended Application No. 10/764,345 filed

on August 8, 2008.

2.   Claims 1-6, 8-9, 12-18 are currently pending and have been fully examined.

3.   For the purpose of applying the prior art, PreGrant Publications will be referred to

using a four digit number within square brackets, e.g. [0001].

Response to Arguments

4.   Applicant's arguments filed on August 8, 2008 have been fully considered, but

they are not persuasive.

Applicant is of the opinion that the prior art of *Vankatesan* does not teach:

> V-37331 is completely silent and thus does not disclose the use of rational statistics. Rational statistics are clarified by the amendments herein and are discussed in the Application in paragraphs [0054]-[0059], at least. [0036]
>
> Furthermore, V-37331 is completely silent and thus does not disclose the use of statistics that have semi-global characteristics. Semi-global characteristics are clarified by the amendments herein and are discussed in the Application in paragraphs [0060]-[0063], at least. [0037]
>
> Consequently, V-37331 does not disclose all of the claimed elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

Where Applicant's specification recites:

> [0063] The "rational" statistics, introduced above, are not local characteristics. Rather, the rational statistics of a region are an excellent example of semi-global characteristics.
>
> [0088] At 618: For each chosen region Ri, the exemplary watermarker computes the random "rational" statistics as a hash value using the digital-goods hashing function of the above Equation 1. That equation is reproduced here for ease of reading:
>
> [0089] At 620, the exemplary watermarker reports the computed hash values (which are the rational statistics). In the watermark embedder, this may be used to embed a watermark via designing a watermarking sequence such that the rational statistics of the watermarked signal are quantized versions of the rational statistics of the original image. In a watermark detector, this may be used to detect, extract, and/or verify a watermark.

[0090] The quantization of rational statistics may be carried out via solving a "minimum-norm" type optimization problem.

The Examiner respectfully disagrees. While it is true that _Vankatesan_ does not expressly use the term "rational" statistics in its disclosure; however, _Vankatesan_ does expressly disclose the mathematical equation used in calculating the "rational" statistics (See at least (col. 11, lines 33-67), (col. 12, lines 1-67)).

Vankatesan also expressly teaches:

> Semi-global characteristics are representative of general characteristics of a group or collection of individual elements. As an example, they may be statistics or features of "regions" (i.e., "segments"). Semi-global characteristics are not representatives of the individual local characteristics of the individual elements; rather, they are representatives of the perceptual content of the group (e.g., segments) as a whole (col. 6, lines 53-60).

> The semi-global characteristics may be determined by a mathematical or statistical representation of a group. For example, it may be an average of the color values of all pixels in a group. Consequently, such semi-global characteristics may also be called "statistical characteristics." Local characteristics do not represent robust statistical characteristics (col. 6, lines 61-67).

> The partitioner 430 separates the transformed good into multiple, pseudorandomly sized, pseudorandomly positioned regions (i.e., partitions). Such regions may overlap. A secret key K is the seed for pseudorandom number generation here. This same K may be used to reconstruct the regions by an exemplary semi-global statistics quantization watermark detecting system 500 (col. 8, lines 51-58).

Applicant argues that _Vankatesan_ does not teach:

> such quantization is based upon semi-global characteristics of regions of the digital good, wherein such semi-global characteristics are generated via a hashing function employing a quotient of at least two weighted linear combinations of statistics of the regions of the digital good.

Vankatesan also expressly teaches:

> performs quantization watermarking based upon semi-global characteristics of multiple regions of the digital good (Abstract).

> The partitioner 430 separates the transformed good into multiple, pseudorandomly sized, pseudorandomly positioned regions (i.e., partitions). Such regions may overlap. A secret key K is the seed for pseudorandom number generation here. This same K may be used to reconstruct the regions by an exemplary semi-global statistics quantization watermark detecting system 500 (col. 8, lines 51-58).

Examples of such pseudo-random statistics may be linear statistics. These linear statistics of a (pseudo-randomly) chosen region are given by weighted linear combination of data in that region (where weights are chosen pseudo-randomly) (col. 5, lines 50-55).

thereby forming the corresponding pseudorandom transformation matrix T.sub.1 of size M.times.N. Thus, the pseudo-random statistic corresponding to R.sub.l is given by .mu..sub.i, where [.mu..sub.l] are found via a weighted linear combination of s in R.sub.l (weights are given by the vectors [.alpha..sub.1])". Later on, these statistics shall be quantized using the length-M watermark vector w .di-elect cons.[0, 1].sup.M (col. 9, lines 16-23).

As to claim 1, Applicant recites, "…wherein the calculating comprises generating the rational statistics of one or more regions...." Examiner would like to point out that the language that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim.[1]

As to claim 2, Applicant recites, "…calculating comprises generating the rational statistics…" However, this is representative of non-functional descriptive information and it has been held that such information will not distinguish a claimed device from the prior art.[2]

As to claims 3 and 4, each recites similar language or contains like deficiencies.

As to claim 9, Applicant recites, "…quantization is based upon semi-global characteristics of regions…" However, this is representative of non-functional

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[1] Texas Instruments Inc. v. International Trade Commission 26, USPQ2d 1010 (Fed. Cir. 1993); Griffin v. Bertina, 62 USPQ2d 1431 (Fed. Cir. 2002); Amazon.com Inc. v. Barnesandnoble.com Inc., 57 USPQ2d 1747 (CAFC 2001); A (whereby/wherein) clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim

[2] In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II; Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability …. [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate

descriptive information and it has been held that such information will not distinguish a

claimed device from the prior art.[3]

As to claim 15, Applicant recites, "...wherein the region-statistics calculator is

further configured to generate the rational statistics of one or more regions of the

plurality via a hashing function, employing a quotient of at least two weighted linear

combinations of statistics of the one or more regions of the plurality." However, this is

describing intended use language and it has been held that the manner in which a

claimed apparatus is intended to be used does not distinguish the claimed apparatus

from the prior art-if the prior art has the capability top so perform.[4]

Claim Rejections - 35 USC § 101

5.   35 U.S.C. §101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

6.   Claims 13-17 are rejected under 35 U.S.C. §101 because the claimed invention

is directed to non-statutory subject matter.

The subject matter of claim 13 is not wholly contained in any one of the four

statutory classes, it appears; therefore, the claim is rejected under 35 U.S.C. §101 (a

claim containing mixed subject matter).[5] The appropriate correction is required.

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[3] In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32
USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II; Where the printed matter is not functionally related to
the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability
…. [T]he critical question is whether there exists any new and unobvious functional relationship between
the printed matter and the substrate
[4] MPEP 2114 and Ex parte Masham, 2 USPQ2d 1647 (1987); A recitation directed to the manner in which
a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art-
if the prior art has the capability to so perform.
[5] MPEP §2173.05(p) II.

Claims 14-17 are also rejected as being dependent upon rejected claim 13.

Claim Rejections - 35 USC § 112, 2nd

7.   The following is a quotation of the second paragraph of 35 U.S.C. §112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

8.   Claims 13-17 are rejected under 35 U.S.C. §112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

As to claim 13, it is considered to be a Hybrid claim since a person of ordinary

skill in the art would recognize that the claim encompasses at least two statutory

classes of invention (a claim containing mixed subject matter).[6]

Evidence that claim 13 recites a system includes: The Preamble ("A system for

facilitating the protection of digital goods..."), dependent claim 14 which begins, "A

system as recited in claim 13...."

Here the Applicant seems to be combining a system claim with a method claim

(set of steps) (e.g. "...further configured to generate the rational statistics of one or more

regions...." "...employing a quotient of at least two weighted linear combinations of

statistics (claim 15)...." Because of the conflicting evidence, the claim is considered a

Hybrid claim and the appropriate correction is required.

Claims 14-17 are also rejected for being dependent upon rejected claim 13. The

appropriate correction is required.

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[6] Id

Claim Rejections - 35 USC § 102

9.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10.   Claims 1-6, 8-9 and 12-18 are rejected under 35 U.S.C. §102(e) as being

anticipated by Venkatesan et al., (US 2004/0001605) ("*Vankatesan*").

As to claim 1:

Vankatesan expressly teaches:

obtaining a digital good (See at least [0085]-[0093] and Claim 1);

partitioning the digital good into a plurality of regions (See at least [0085]-[0093] and Claim 1);

calculating rational statistics of one or more the regions of the plurality, so that the statistics of a region are representative of the region, wherein the calculating comprises generating the rational statistics of one or more regions of the plurality via a hashing function having quotient of two weighted, linear, statistical combinations and wherein the rational statistics are semi-global characteristics (See at least [0085]-[0093] and Claim 1);

quantizing the rational statistics (See at least [0085]-[0093] and Claim 1);

marking the digital good with the quantized rational statistics of the plurality of the regions (See at least [0085]-[0093] and Claim 1).

As to claim 2:

Vankatesan expressly teaches:

> wherein the calculating comprises generating the rational statistics of one or more regions of the plurality via a hashing function (See at least [0097]-[0099]).

As to claim 3:

Vankatesan expressly teaches:

> wherein the calculating comprises generating the rational, statistics of one or more regions of the plurality via a hashing function employing a quotient of at least two weighted linear combinations of statistics of the one or more regions of the plurality (See at least [0097]-[0099]).

As to claims 4 and 17:

Vankatesan expressly teaches:

> wherein h of the hashing function is: (See at least pages 5-9)

As to claim 5:

Vankatesan expressly teaches:

> wherein the partitioning comprises segmenting the digital good into a plurality of overlapped regions (See at least [0092] and Claim 2).

As to claim 6:

Vankatesan expressly teaches:

> wherein the marking comprises embedding a watermark via quantization (See at least [0100], [0106], and Claim 8).

As to claim 7:

> (Cancelled)

As to claim 8:

Vankatesan expressly teaches:

> A computer comprising one or more processor-readable media as recited in claim 1 (See at least [0002], [0056], [0224] and Claim 10).

As to claim 9:

Vankatesan expressly teaches:

> obtaining a digital good(See at least [0085]-[0093] and Claim 1); and

> using quantization (See at least Abstract, [0016], [0044], [0046], [0049], [0062], [0065], [0066], [0189], [0198]-[0199], Figure 7),

> marking the digital good with a watermark (See at least [0007], [0014], [0019], [0029]-[0030], [0044], [0046], [0049], [0068], [0076], Figure 1);

> wherein such quantization is based upon semi-global characteristics of regions of the digital good (see at least Abstract, [0050], [0069]-[0074], [0092], Claim 23-28, 33);

> wherein such semi-global characteristics are generated via a hashing function employing a quotient of at least two weighted linear combinations of statistics of the regions of the digital good (see at least Abstract, [0050], [0069]-[0074], [0092], Claim 23-28, 33);

As to claim 10:

> (Cancelled)

As to claim 11:

> (Cancelled)

As to claim 12:

Vankatesan expressly teaches:

> A computer comprising one or more processor-readable media as recited in claim 9 (See at least [0221], Figure 10, Claim 32);

As to claim 13:

Vankatesan expressly teaches:

> a partitioner configured to segment a digital good into a plurality of regions (See at least [0085], [0090], [0092]-[0093], [0095], [0098], Claim 40);

> a region-statistics calculator configured to calculate rational statistics of one or more of the plurality of regions, wherein the statistics of a region are representative of that region, wherein the region-statistics calculator is further configured to generate the rational statistics of one or more regions of the plurality via a hashing function having quotient of two weighted, linear, statistical combinations and wherein the rational statistics are semi-global characteristics (See at least [0085], [0098], [0100], [0109]-[0110], Claim 40);

> a region quantizer configured to quantize such the rational statistics of a region (See at least Claim 40);

> a digital-goods marker configured to generate a marked good using the quantized rational statistics (See at least Claim 40).

As to claim 14:

Vankatesan expressly teaches:

> wherein the region-statistics calculator is further configured to generate the rational statistics of one or more regions of the plurality via a hashing function (See at least [0098], [0206], [0215]-[0216], Claim 40).

As to claim 15:

Vankatesan expressly teaches:

> wherein the region-statistics calculator is further configured to generate the rational statistics of one or more regions of the plurality via a hashing function, employing a quotient of at least two weighted linear combinations of statistics of the one or more regions of the plurality (See at least [0049], [0061], [0097]-[0098], [0121]-[0122], [0132], [0178]-[0179]).

As to claim 16:

Vankatesan expressly teaches:

> wherein the partitioner is further configured to segment a digital good into a plurality of overlapping regions (See at least [0030], [0044], [0065], [0073]-[0082], Figure 3, Claim 42).

As to claim 18:

Vankatesan expressly teaches:

> obtaining a digital good (See at least [0085-[0093], Figure 10, Claim 1);

> partitioning the digital good into a plurality of regions (See at least [0085]-[0093] Figure 4-6, Claim 1);

> wherein the partitioning comprises segmenting the digital good into a plurality of overlapped regions (See at least [0092], and Claim 2);

> calculating rational statistics of one or more the regions of the plurality, so that the statistics of a region are representative of the region, wherein the rational statistics are semi-global characteristics (See at least [0085]-[0093] and Claim 1);

> quantizing the rational statistics (See at least [0085]-[0093] and Claim 1);

> marking the digital good with the quantized rational statistics of the plurality of the regions, wherein the marking comprises embedding a watermark via quantization, wherein the calculating comprises generating the rational statistics of one or more regions of the plurality via a hashing function, h, that hashing function having quotient of two weighted, linear, statistical combinations (See at least [0085]-[0093] and Claim 1);

<div align="center">Double Patenting</div>

11.   The nonstatutory double patenting rejection is based on a judicially created

doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-

type double patenting rejection is appropriate where the conflicting claims are not

identical, but at least one examined application claim is not patentably distinct from the

reference claim(s) because the examined application claim is either anticipated by, or

would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29

USPQ2d 2010 (Fed. Cir. 1993); In re Lon.qi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); In re Van Omum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Voqel, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorinqton, 418 F.2d 528, 163 USPQ

644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 C.F.R. §1.321(c) or

§1.321(d) may be used to overcome an actual or provisional rejection based on a

nonstatutory double patenting ground provided the conflicting application or patent

either is shown to be commonly owned with this application, or claims an invention

made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a

terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with

37 C.F.R. §3.73(b).

12.   Claims 1, 5, 6, 8, 12, 13 and 16 are rejected under the judicially created doctrine

of provisional obviousness-type double patenting as being unpatentable over claims 1-

42 of U.S. Pub. 2004/0001605 and also adds the bolded portions as shown ion

comparison "Table 1" below.   ****Please note similar language is in **BOLD**.

Claim 1 of U.S. Pub. 2004/0001605	Claim 1 of instant application # 10/764,345
1. A computer-readable medium having computer-executable instructions that, when executed by a computer, performs a method facilitating protection of digital goods, the method comprising: **obtaining a digital good;** transforming the good; **partitioning the transform of the good into a plurality of permissively overlapped regions;** **calculating statistics of one or more the regions of the plurality, so that the statistics of a region are representative of it;** **quantizing such statistics;** generating a perceptual-compensation factor, which is an approximate representation a combination of the quantized statistics of the plurality of the regions; **marking the digital good with the perceptual-compensation factor.**	1. A processor-readable medium having processor-executable instructions that, when executed by a processor, performs acts comprising: **obtaining a digital good;** **partitioning the digital good into a plurality of regions;** **calculating rational statistics of one or more the regions of the plurality, so that the statistics of a region are representative of the region,** wherein the calculating comprises generating the rational statistics of one or more regions of the plurality via a hashing function having quotient of two weighted, linear, statistical combinations and wherein the rational statistics are semi-global characteristics; **quantizing the rational statistics;** **marking the digital good with the quantized rational statistics of the plurality of the regions.**

13.   Since the U.S Patent and Trademark Office normally will not institute an

interference between applications or a patent and an application of common ownership

(see MPEP Chapter 2300), the assignee is required to state which entity is the prior

inventor of the conflicting subject matter. A terminal disclaimer has no effect in this

situation since the basis for refusing more than one patent is priority of invention under

35 U.S.C. §102(f) or (g) and not an extension of monopoly. Failure to comply with this
requirement will result in a holding of abandonment of application. This is a double
patenting rejection.

14.   **Examiner's Note**: The Examiner has pointed out particular references contained
in the prior art of record within the body of this action for the convenience of the
applicant. Although the specified citations are representatives of the teachings in the art
and are applied to the specific limitations within the individual claim, other passages and
figures may apply. Applicant, in preparing the response, should consider fully the entire
reference as potentially teaching all or part of the claimed invention, as well as the
context of the passage as taught by the prior art or disclosed by the Examiner.

Conclusion

15.   **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time
policy as set forth in 37 C.F.R. §1.136(a).

        A shortened statutory period for reply to this final action is set to expire THREE
MONTHS from the mailing date of this action. In the event a first reply is filed within
TWO MONTHS from the mailing date of this final action and the advisory action is not
mailed until after the end of the THREE-MOTNH shortened statutory period, then the
shortened statutory period will expire on the date of the advisory action is mailed, and
any extension fee pursuant to 37 CFR §1.136(a) will be calculated from the mail date of
the advisory action. In no event, however, will the statutory period for reply expire later
than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to

Applicant's disclosure.

Any inquiry concerning this communication or earlier communication from

the examiner should be directed to **Mr. Dante Ravetti** whose telephone number is

(571) 270-3609. The examiner can normally be reached on Monday – Thursday

9:00am-5:00pm.

If attempts to reach examiner by telephone are unsuccessful, the

examiner's supervisor, **Mr. Calvin Hewitt II** may be reached at **(571) 272-6709**. The

fax phone number for the organization where this application or proceeding is

assigned is **(571) 270-4609**.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information

for published applications may be obtained from either Private PAIR or Public

PAIR. Status information for unpublished applications is available through

Private PAIR only. For more information about the PAIR system see

http://pair-direct.uspto.gov. Should you have questions on access to the private

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217-9197. If you would like assistance from a USPTO Customer Service

Representative or access to the automated information system, call 1-(800) 786-

9199 (IN USA or CANADA) or 1-(571) 272-1000.

/Dante Ravetti/
Examiner, Art Unit 3685
Sunday, October 12, 2008

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685